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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,424	12/12/2003	Bernhard Sander	DT-6716	3920

30377 7590 06/29/2005

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EXAMINER
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GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/734,424

**Applicant(s)**

SANDER ET AL.

**Examiner**

Ernesto Garcia

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005 and 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Pages 11 and 12.

## DETAILED ACTION

### *Election of Species*

Applicants' remarked that the species I should have been Figures 1 and 3b instead of Figures 1 and 3a. The examiner agrees as the description is accurate and the drawings are inaccurate. Based on the remarks made by applicants, applicants' election of Species I, Figures 1 and 3b, in the reply filed on April 25, 2005 is acknowledged. Because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 3-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 25, 2005. In regards to the withdrawal of claim 3, the contact means 4b, in Figure 1, do not comprise pointform contact tips on the tool 3. There is nothing that resembles a pointform contact tip on the tool 3 of Figure 1 and therefore claim 3 is not readable on Figure 1.

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner on form PTO-892 has cited the references, they have not been considered.

### ***Drawings***

The drawings are objected to because one view must not be placed upon another or within the outline of another. The elevation view is placed upon the cross-sectional view or vice versa in Figures 1 and 2. See 37 CFR 1.84(i). See MPEP 608.02(e).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4a" has been used to designate both contact means comprising a flat surface (Figure 1) and contact means comprising a tapered surface (Figure 2).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4b" has been used to designate both a contact means comprising a flat surface (Fig. 1) and a contact means comprising a tapered surface (Fig. 2).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "3" has been used to designate both a tool with one configuration (Fig. 1) and a tool with a second configuration.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "6" has been used to designate tips with one configuration (Figs. 1 and 3b), a second configuration (Figs. 2 and 3a), a third configuration (Figure 3c) and a fourth configuration (Fig. 3d). See MPEP 608.02(e).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate a tool receptacle with a first configuration (Fig. 1; plurality of pointform tips and pre-stressing means), a second configuration (Figure 2, tips being annular), a third configuration (Figure 3a; one annular tip and no pre-stressing means), a fourth configuration (Figure 3b; pointform tips, no pre-stressing means), a fifth configuration (Fig. 3c, no pre-stressing means), and sixth configuration (Figure 3d, no pre-stressing means).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicants will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

on page 4, in line 9, "shwon" should be --shown--. Appropriate correction is required.

***Claim Objections***

Claims 1, 2, and 8 are objected to because of the following informalities:

regarding claim 1, reference character "4a" is shown twice in the parenthesis of line 3, and one of the open parenthesis needs to be deleted;

regarding claim 2, --at least one-- needs to be inserted after "said" in line 2 as contact tips are only present in the tool receptacle 2; and,

regarding claim 8, "receptacle" needs to be deleted and --receptacle-- needs to be inserted as the drawings show the biasing member extending from the tool and not the tool receptacle. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it is unclear whether the "contact tips" in line 1 are the same pointform contact tip as recited in line 6 of claim 1, or separate features.

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Regarding claim 7, the metes and bounds of the claim are unclear. Applicants have not positively claimed the pre-stressing means in claim 1. It appears that applicants are intending to claim the pre-stressing means by further limiting the pre-stressing means, or if applicants are not claiming the pre-stressing means, how does claim 7 further limit the coupling. For purposes of examining claim 7, the examiner has considered the combination of the coupling and the pre-stressing means.

Regarding claim 8, the claim depends from claim 7 and therefore is indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hembree et al., 6,045,026 (see marked-up attachment).



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Regarding claim 1, Hembree et al. disclose, in Figure 2, a coupling between a tool receptacle **24** and a tool **14** with two oppositely directed contact means **20,A20** facing one another. At least one of the contact means **A20** has a pointform **48**.

Applicants should note that the contact means **20,A20** are capable of being pre-stressed by a pre-stressing means.

Regarding claim 2, contact tips **52** are spaced apart forming the --at least one-- contact means **20,A20**.

Claims 1, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Aoki et al., 6,679,282 (see marked-up attachment).

Regarding claim 1, Aoki et al. disclose, in Figure 2, a coupling between a tool receptacle **1** and a tool **2** with two oppositely directed contact means **26,35** facing one another. At least one of the contact means **26,35** has a pointform **A4**.

Applicants should note that the contact means **26,35** are capable of being pre-stressed by a pre-stressing means.

Regarding claim 7, Aoki et al. disclose the coupling in combination with a pre-stressing means **5,20,30**,. The pre-stressing means **5,20,30**, comprises an axially directed screw-thread biasing member **5**.

Regarding claim 8, the screw-thread biasing member extends axially from the tool receptacle **1** into a threaded bore **20** extending axially into the tool **2**.

### ***Conclusion***


The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kondo, 6,609,648, shows a similar a similar coupling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GREGORY J. BONDA**  
**PRIMARY EXAMINER**

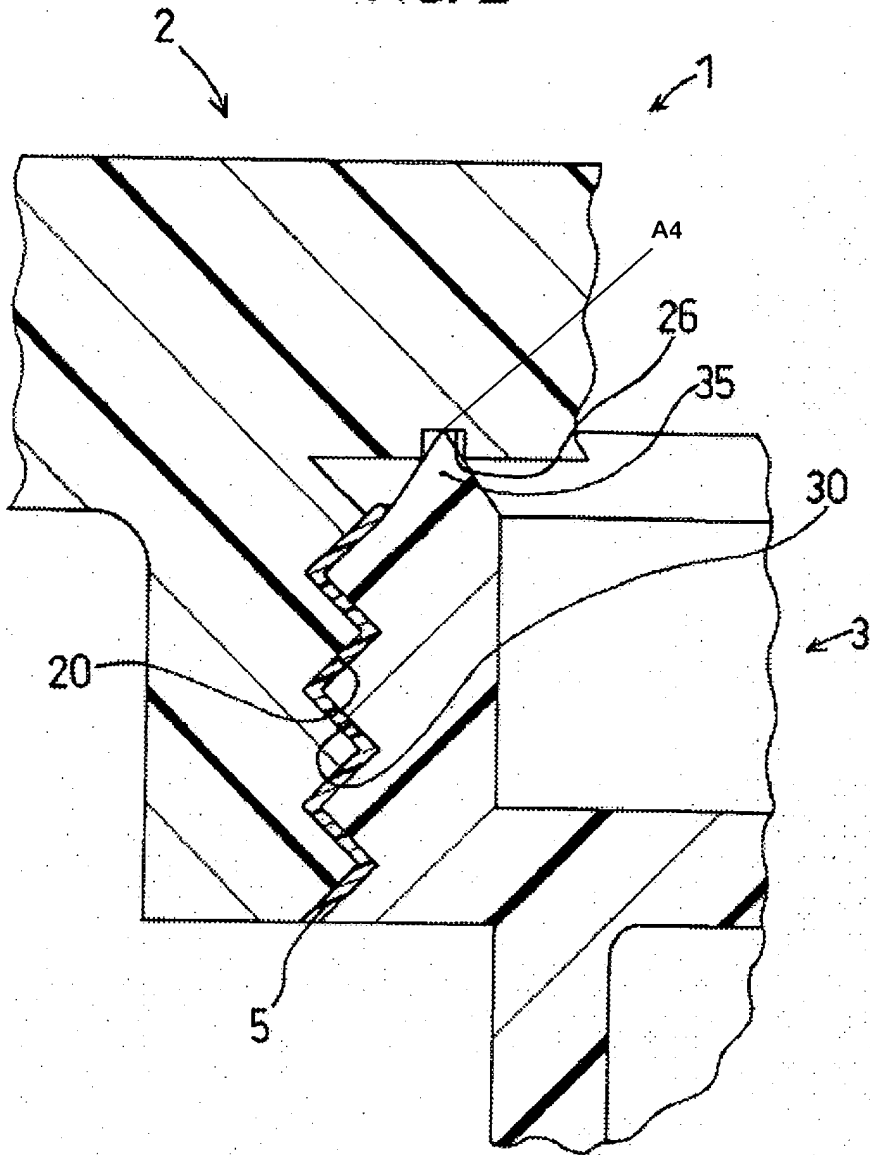
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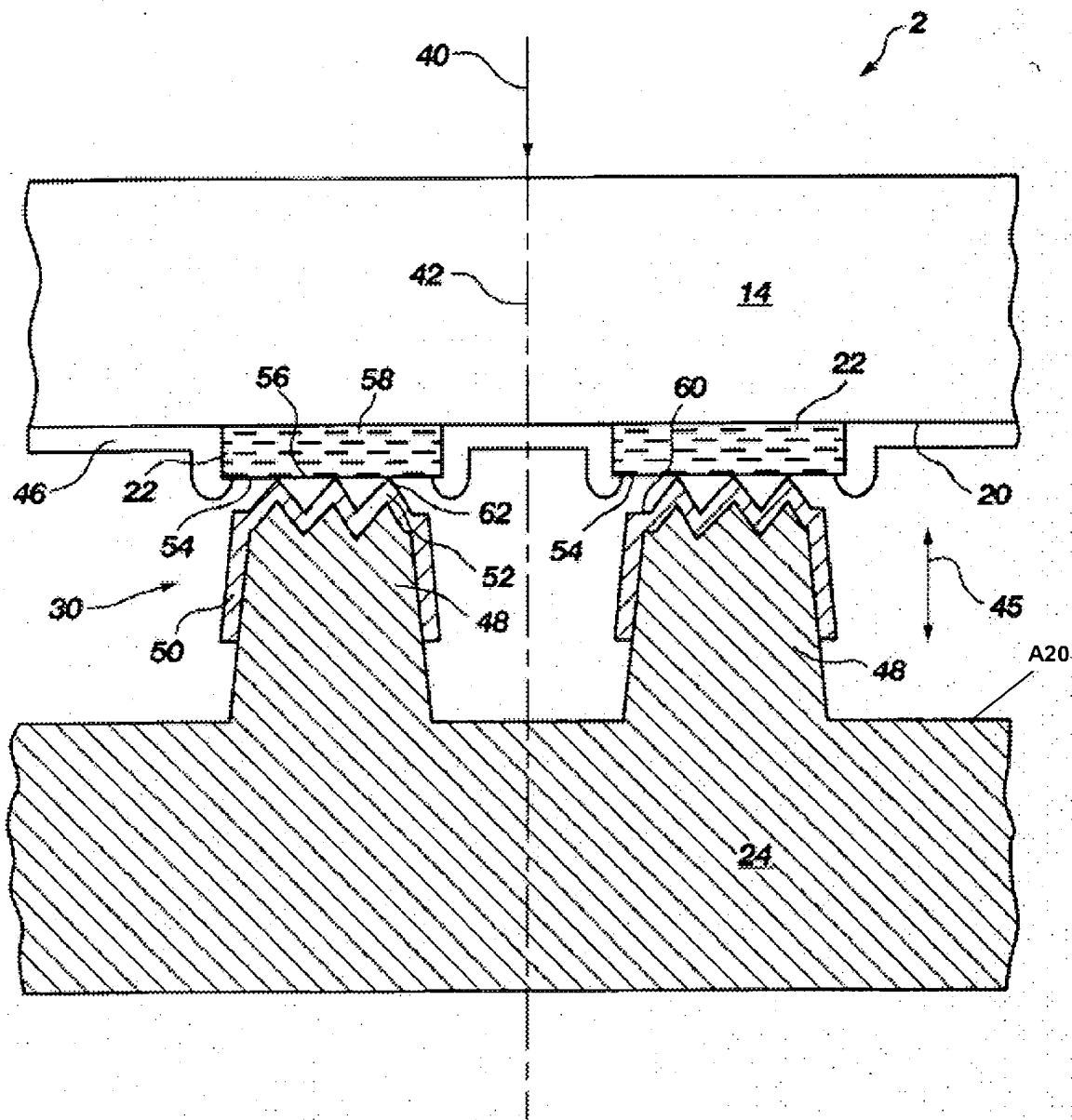
June 24, 2005

Attachments: one marked-up page of Aoki et al., 6,679,282; and,  
one marked-up page of Hembree et al., 6,045,026

Aoki et al., 6,679,282

FIG. 2





**Fig. 2**